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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/689,407

10/20/2003

Sam Johnson

01003.1010

2572

35856

7590

04/24/2007

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EXAMINER

PANDYA, SUNIT

ART UNIT

PAPER NUMBER

3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/24/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/689,407	<b>Applicant(s)</b> JOHNSON, SAM	
	<b>Examiner</b> Sunit Pandya	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendment***

***Continued Examination***

1. This office action is in response to an amendment filed 3/13/2007, wherein claims 1, 3-4 have been amended.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999).

The term "naturally occurring outcome" in claim 1 is used by the claim to mean "any possible outcome", while the accepted meaning is "without artificial help." The term is indefinite because the specification does not clearly redefine the term.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joshi (US Patent Number 6,843,723) in view of Bronson et al. (US Patent Number 6,682,432).

**Claim 1:** Joshi teaches a system for providing closed-loop operation for promotional events for a video gaming machine with a defined payout table (figure 1, 10; figures 4 & 10 and also col. 2: 4-11). The promotional event is associated with particular winning criteria – i.e., as determined by the modified payout structure (col. 2: 32-39). Joshi describes a controller box that is operable to interface to the video gaming machine and is interconnected to the main processor of the gaming machine (figure 2, 16 and col. 10: 4-19). Joshi describes storing the visual element datasets in a memory device (20) that interfaces with the game machine processor (col. 2: 40-42). This combination of memory device and processor is a controller box that is operable to interface to the video gaming machine. There may be a promotional server (152) that is communicatively coupled to the controller box and operable to maintain a database of promotional events with each promotional event having promotional content (visual motif, wherein the game to operation of the game continues on the machine), winning criteria (modifiable payout structure) and scheduling information (a list of holidays, start and stop times). (See Summary of the Invention section.) As noted above, this information is loaded into the memory device. Thus the server (152) delivers to the controller box, at least a portion of the database

Art Unit: 3714

of promotional events. The controller box displays promotional content on the display of the video gaming machine. Figures 12 & 13 show the display of Christmas promotional content. The controller box, which includes the CPU (16), monitors the activity of the video gaming machine to determine if the winning criteria have been met. The controller box provides information indicating that the winning criteria for a particular promotional event have been satisfied – by causing payout mechanism (22) to pay out winnings (col. 12: 48-9).

Joshi does not specifically disclose that the promotional server receives from the controller box, messages indicating that the winning criteria for a particular promotional event have been met. It is well known to send all information regarding winnings to a server for casino accounting purposes. Bronson teaches reporting winning conditions to an accounting server (71 and col. 6: 22-36). This allows the casino to keep track of the money paid out – a matter of vital importance. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Joshi in view of Bronson to have the server receive messages from the controller box indicating that the winning criteria for a particular promotional event have been met in order to allow the casino to keep track of money paid out.

**Claim 2:** The promotional server includes a software program that enables a user to define particular promotional events by defining an award to be associated with the promotional event (i.e., designating the modified payout structure); defining a schedule for the promotional event; defining the winning criteria for the promotional

event; receiving instructions to store the defined promotional event; and storing the defined promotional event into the database (see summary of the invention).

**Claim 3:** The software program further comprises an interface to upload graphical and textual content to be included in the promotional content, wherein an operator can modify and define promotional event and other player appeal features (col. 10: 4-18, 56-11 & 12-13: 48-9).

**Claim 4:** The software program must include an interface to create graphics and textual content to be included in the promotional content, wherein an operator can modify and define promotional event and other player appeal features (col. 12-13: 48-9, the data must be created before it can be downloaded.)

**Claim 5:** The controller box is associated a single video gaming machine that is associated to a single user and is operative to display the promotional content in accordance with the scheduling information (figure 18A, wherein the change in promotional content will not alter the gaming method or the content associated with the gaming machine).

**Claim 6:** The controller box is operative to receiving entertainment content (i.e., game motifs) from an entertainment source (152) and to display the entertainment content on the display of the video gaming machine.

**Claims 7-10:** Joshi teaches implementation on both video poker and video blackjack machines (col. 15: 38-40). While the choice of which hands to make into winning criteria is a matter of design choice – any combination of cards could be considered a “winning hand”, Joshi teaches that the winning criteria may be the

appearance of three symbols that are not included on the payout table (col. 5: 57-60).

Thus Joshi teaches winning combinations that are not in the payout table and teaches winning combinations that are a particular hand (figs 4A & B).

### ***Response to Arguments***

5. Applicant's arguments filed 3/13/2007 have been fully considered but they are not persuasive.

The applicant argues that Joshi does not disclose all of the claimed limitation of claim 1. The examiner respectfully disagrees. The rejection above does teach of all the elements disclose within claim 1, since the prior art structure is capable of performing the same function cited in the claim, the cited reference meets the claim's limitation.

Specifically the applicant argues that Joshi does not disclose a control box, which displays promotional content on the gaming machine, monitors the activity of the video gaming machine to determine if the winning criteria has been met and provide information indicating the wining criteria for a particular promotional event has been satisfied. However Joshi clearly discloses a gaming machine capable of achieving all of the claimed elements, including a controller interfacing to the gaming machine (col. 10: 4-19) wherein Joshi teaches of a controller or a control box which interfaces with the gaming machine processor, that displays promotional content on the display of the video gaming machine. (Figures 12 & 13 show the display of Christmas promotional content.) The promotional event is associated with particular winning criteria – i.e., as determined by the modified payout structure. (Col 2, 32-39) Combination of Joshi and

Art Unit: 3714

Brosnan teaches reporting winning conditions to an accounting server (71). Since the device disclosed by combination of Joshi and Brosnan discloses all of the limitation disclosed within claim 1, the rejection is maintained.

The applicant argues that Joshi does not describe a controller that operates to display promotional content on the display of the video gaming machine. The examiner respectfully disagrees with that, Joshi teaches, as disclosed above in the rejection, changes the motif of the game or the display characteristics of the game theme, where different themes can be implemented in a gaming machine depending on situations. However by changing the motif of the game, Joshi by no means changes the underlying game, which is still intact, including all the payout tables, paylines and winning combination for the game. Joshi, by changing the motif (i.e. Christmas theme), allows for the game machine to display promotional content on the display means of in a manner that allows the game to continue to be present and active on the machine, as recited in claim 1 (see rejection above).

Regarding the applicant's arguments that the cited reference does not describe, suggest or teaches certain limitation as recited in claim 1 and as described in the specification. The examiner respectfully disagrees with the applicant, all of the claimed limitations have been disclosed in the rejection above, as interpreted by the examiner. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).



Art Unit: 3714

Regarding the applicant's arguments that the reference Joshi does not teach ability to change anything in the operation of the game, as disclosed in claims 3 and 4. The examiner respectfully disagrees with the applicant. See rejection above which has been modified to reflect the amendments.

Consequently, for the reasons given above, the rejection is maintained.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

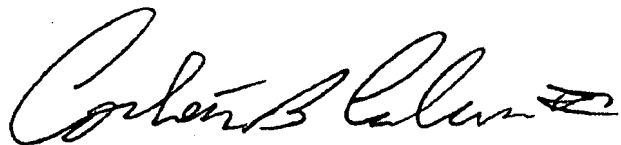
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunit Pandya whose telephone number is 571-272-2823. The examiner can normally be reached on 8 am - 5:30 pm.

Art Unit: 3714

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SP

A handwritten signature in black ink, appearing to read "Corbett B. Coburn" with a stylized flourish at the end.

**CORBETT B. COBURN  
PRIMARY EXAMINER**